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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,901	09/22/2000	Daniel A. Nolan	RM233d	2273

23996 7590 06/04/2004

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EXAMINER

KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
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2654

DATE MAILED: 06/04/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/668,901

**Applicant(s)**

NOLAN, DANIEL A.

**Examiner**

David D. Knepper

**Art Unit**

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-44 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's correspondence filed on 22 September 2000 (paper #2) has been received and considered. Claims 1-44 are pending.

**Missing Items**

2. The Reissue transmittal indicates that a statement under 37 CFR 3.73(b) was provided but it is not in the application file.

Similarly, the Reissue Application Declaration by the Inventor refers to a "Chain of assignment copies attached as Exhibit A which is not present in the file.

It is noted that an offer to surrender and a declaration are present and signed by Mr. Orville K. Hollenbeck on behalf of the assignee. There is also a copy of an assignment by the inventor, Daniel A. Nolan, to Tracer Round Associates, Ltd. Therefore, examination will proceed with the understanding that missing documentation will be provided with the next response to this Office Action.

3. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
4. Applicant is reminded of the continuing obligation under 37 CFR 1.178(b), to timely apprise the Office of any prior or concurrent proceeding in which Patent No. 5812978 is or was involved. These proceedings would include interferences, reissues, reexaminations, and litigation.

Applicant is further reminded of the continuing obligation under 37 CFR 1.56, to timely apprise the Office of any information which is material to patentability of the claims under consideration in this reissue application.

These obligations rest with each individual associated with the filing and prosecution of this application for reissue. See also MPEP §§ 1404, 1442.01 and 1442.04.

5. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

6. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

**Defective Amendment**

7. The matter to be added by reissue must be underlined, except for amendments submitted on compact discs ( § § 1.96 and 1.821(c)). The new claims were improperly presented.

**Defective Declaration**

8. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The general allegation that “Claims as issued are too narrow” is not sufficient. The applicant must address specific claim language explaining why the error renders the claims defective or inoperable. This statement appears on a declaration signed by Orville K. Hollenbeck and on a second declaration, unsigned by the inventor.

The declaration signed by Orville K. Hollenbeck does identify the full name of the inventor. It only contains the inventor’s last name.

9. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

It lacks the inventor’s signature (see 37 CFR 1.42, 1.43, 1.47 and 37 CFR 1.172). This is a lack of compliance under 37 CFR 1.175(a).

10. Claims 1-44 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

### **Restriction**

11. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 13, 19, 21-23, 25-28, 31, 32 and 37-44, drawn to a speech controlled motorized wheelchair, classified in class 704, subclass 271 (Handicap Aid). See also Class 180/907 (Motorized Wheel Chairs).
- II. Claims 10-12, 14-18, 20, 24, 29, 30 and 33-36, drawn to speech controlled, power driven equipment, classified in class 704, subclass 275 (Speech Controlled System).

12. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the power driven equipment (non-wheel chair) inventions are disclosed in the specification in column 2, lines 23-26 as including beds, therapy devices, electromechanically augmented powered skeletal supports, and television, stereo and other electronic equipment. The divergent subject matter listed in the specification would require a much broader search of devices that cannot be used together.

For invention II, additional class/subclass information that would need to be searched is voluminous and diverse, including: Class 5 BEDS; Class 348 TELEVISION; Class 381 ELECTRICAL AUDIO SIGNAL PROCESSING SYSTEMS AND DEVICES / subclass 1+ (BINAURAL AND STEREOPHONIC); Class 602 SURGERY: SPLINT, BRACE, OR BANDAGE and others.

13. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

15. Because this application is a Reissue, examination of the defects (i.e. – 35 USC 251) was conducted in combination with the Restriction requirement in order to further prosecution.

16. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

TC2600 Fax Center  
(703) 872-9314

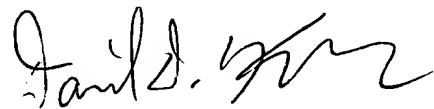
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644.

The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-9645.

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.



David D. Knepper  
Primary Examiner  
**Art Unit 2654**  
June 3, 2004